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PATENT
Customer Number 22,852
Attorney Docket No. 05552.1450

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
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Carsten SCHELP et al.) Group Art Unit: 1641
)
Application No.: 10/024,258) Examiner: D. Davis
)
Filed: December 21, 2001)
)
For: DETECTION METHODS)

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In a restriction requirement dated February 2, 2005, the Examiner required restriction under 35 U.S.C. § 121 among the following groups of claims:

Group I: Claims 1-22, drawn to a method for detecting an analyte A wherein R2 is an analyte A specific binding partner which saturates analyte-A binding sites at a higher analyte A concentration than the analyte A specific binding partners wherein L1-dependent measurement signal is determined at different times from L2 dependent measurement signal or L1 plus L2 dependent measurement signal classified in class 435, subclass 7.1;

Group II: Claims 1-22, drawn to a method for detecting an analyte A wherein R2 is an analyte A specific binding partner which saturates analyte-A binding sites at a

higher analyte A concentration than the analyte A specific binding partners, determining L1-dependent measurement signal using different measurement method than used to determine the L2 dependent measurement signal or the L1 plus L2 dependent measurement signal classified in class 435, subclass 4;

Group III: Claims 23-31, drawn to a kit, classified in class 436, subclass 808.

Applicants elect, with traverse, the subject matter of Group I, claims 1-22.

The Examiner alleges that Group I is distinct from Group II because the methods of each are materially distinct and differ at least in objectives, method steps, reagents and/or dosages and/or schedules used, response variables, and criteria for success. Applicants note that the incubation step of the claimed method of both groups is identical and thus the Examiner is only relying on the determination step, which in the original claim 1 has two alternate parts, as the basis for the restriction requirement. Although the inventions of Groups I, II, and III may be independent or distinct as claimed, Applicants respectfully submit that the Restriction Requirement between Groups I-III is improper and should be withdrawn.

According to MPEP § 803, there are two requirements that must be met before a proper Restriction Requirement may be made. These two requirements are: "The inventions must be independent . . . or distinct as claimed; and there must be a serious burden on the Examiner if restriction is required" (Emphasis added). Applicants respectfully submit that the Examiner has failed to establish the second requirement set forth in MPEP § 803, that the search and examination of the entire application constitutes a serious burden on the Examiner.

The examination of Groups I and II both occur within one class, 435. Moreover, examination of the incubation steps of both groups is identical. Applicants respectfully assert that the examination of Group II will overlap with the examination of Group I. Accordingly, Applicants request that if the Group I claims are allowable that the Examiner will extend examination to the claims of Group II.

The kit claims of Group III are related to Groups I and II as products and process of use. Although Group III is classified in a different class, examination of the method claims will inevitably involve some examination of the kit claims. In the event that the process claim of either or both of Groups I and II is found allowable, the Examiner is requested to rejoin the kit claims to the allowed process claim(s).

MPEP § 803 states that "[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims directed to distinct or independent inventions." (Emphasis added). As discussed above, there would be considerable overlap between the examinations of Groups I, II, and III and it is therefore respectfully asserted that the search and examination of the entire application could be made without serious burden.

For at least these reasons, and in order to avoid unnecessary delay and expense to Applicants and duplicative examination by the Patent Office, it is respectfully requested that the Restriction Requirement be reconsidered and withdrawn.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: May 2, 2004

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